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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION N |
|---|-------------|----------------------|---------------------|----------------|
| 09/964,062  | 09/26/2001  | Kazuyuki Matsumoto   | CU-2676 RJS         | 1441           |
| 26530   | 7590        | 10/19/2004           | EXAMINER            |                |
| LADAS & PARRY LLP<br>224 SOUTH MICHIGAN AVENUE<br>SUITE 1200<br>CHICAGO, IL 60604 |             |                      | PRONE, JASON D      |                |
|   |             |                      | ART UNIT            | PAPER NUMBER   |
|   |             |                      | 3724                |                |

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/964,062

Applicant(s)

MATSUMOTO ET AL.

Examiner

Jason Prone

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) 3 and 4 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 September 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "substrate sheet" and "a pair of nip rollers", of claim 1, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. The "substrate sheet" and "a pair of nip rollers" are shown in the Figures labeled prior art, however the claimed invention refers to Figures 1-6(c) in which the "substrate sheet" and the "pair of nip rollers" are not shown.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the examiner does not accept the changes, the applicant will be

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notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

2. The disclosure is objected to because of the following informalities: On page 14 line 10, the phrase "suction cups 29...29" should be replaced with "suction cups 29". All reference numbers including the "..." then a repeat of the number should be changed as shown in the previous sentence. On page 14, line 12, the phrase "hold stationarily them" should be replaced with "hold them stationary". On page 15 line 2, the phrase "Robot bodies 37 and 47" should be replaced with "Robot bodies 39 and 47". On page 16 line 28, the phrase "cutting lines 3 and 4" should be replaced with "cutting lines CL 3 and CL 4". On page 17 line 1, the phrase "cutting lines 1 and 2" should be replaced with "cutting lines CL 1 and CL 2". On page 17 line 4, the phrase "and 2" should be replaced with "and CL 2". On page 17 line 6, the phrase "cutting lines CL 3 and 4" should be replaced with "cutting lines CL 3 and CL 4". On page 17 line 8, the phrase "cutting line CL 3 or 4" should be replaced with "cutting line CL 3 or CL 4". On page 17 line 10, the phrase "cutting lines CL 3, 4, 1 and 2" should be replaced with "cutting lines CL 3, CL 4, CL 1, and CL 2".

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claims 1 and 2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. In regards to claim 1, on line 2 the phrase "heating step" and on line 10 the phrase "heating the synthetic resin sheet" are unclear. It is uncertain if these heating steps are the same step or if they are separate steps.

6. In regards to claim 1, the phrase "a substrate sheet" is unclear. It is uncertain what structure the substrate sheet incorporates and where it is located in the present invention.

7. In regards to claim 1, the phrase "a pair of nip roller" is unclear. It is uncertain what structure the nip rollers incorporate and where they are located in the present invention.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted prior art (Figs. 7(A)-8(B) and the "Description of Related art" section of the instant application") (From now on, referred to as AAPA) in view of the Japanese reference to Nishigaito, the British reference 1,074,662,

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and Mikkelsen. AAPA discloses the invention including a method for cutting a synthetic resin sheet for a lens which is to be carried out immediately after a heating step of a manufacturing process of the synthetic resin sheet, in which a forming die, ultra-violet ray curing type resin applied thereon and a substrate sheet placed on the ultraviolet ray curing type resin are supplied in a predetermined direction into a space between a pair of nip rollers, to manufacture the synthetic resin sheet having a first pair of opposite side portions extending substantially perpendicularly to the predetermined direction and a second pair of opposite side portions extending substantially in parallel with said predetermined direction (Figs. 7(A)-8(B) and the "Description of Related art" section of the instant application"), and cutting the first pair of opposite side portions and cutting the second pair of opposite side portion (third paragraph of the "Description of Related art" section) but fails to disclose a method of heating a workpiece, determining its expected expansion, and cutting the workpiece immediately after heating so as to compensate for its expansion when it is cooled, and performing said operation on a synthetic resin sheet for a lens. However, Nishigaito teaches a method of heating a workpiece, determining its expected expansion, and cutting the workpiece so as to compensate for its expansion when it is cooled (see translated abstract). Also, the British reference 1,074,662 teaches performing an operation to compensate for expansion during heating of a synthetic resin sheet. While the British reference 1,074,662 does not explicitly teach performing heating with expansion-adjusted cutting on a synthetic resin sheet, it does show that it is well known that a sheet-shaped plastic workpiece is deformed when it undergoes heating processes and it may be desirable to

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build into the process elements that compensate for this deformation (see claim 1, see also the abstract of the European reference to Guntell et al.). Also, Mikkelsen teaches cutting a plastic lens immediately after heating (abstract col. 1, lines 38-60, col. 6, lines 4-8). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the method of Fujita with the method of heating a workpiece, determining its expected expansion, and cutting the workpiece so as to compensate for its expansion when it is cooled as taught by Nishigaito; the dimensional compensation of a heat-worked synthetic resin sheet as taught by the British reference 1,074,662, and the cutting of a plastic lens immediately after heating of Mikkelsen for effective dimensional control of the workpiece.

Furthermore, regarding claim 2, it would be obvious to perform steps similar to those described in claim 1 on a synthetic resin sheet for a lens having a plurality of prescribed cutting lines since doing so would constitute merely repeating the steps described in claim 1.

### ***Response to Arguments***

10. Applicant's arguments with respect to claims 1 and 2 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Matsumoto et al.

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Prone whose telephone number is 703-605-4287.

The examiner can normally be reached on 7:30-5:00, Mon - (every other) Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 703-308-1082. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JP  
October 14, 2004



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